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# PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2003-IP-011522 U1 USA

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on APRIL 17, 2006

Signature *Sheppa Suftko*

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Application Number

10/760,649

Filed

January 20, 2004

First Named Inventor

Ronald G. Dusterhoft

Art Unit

3672

Examiner

K. Thompson

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

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attorney or agent of record.

Registration number 38,310

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

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Typed or printed name

972-516-0030

Telephone number

April 15, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

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\*Total of 1 forms are submitted.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of: Ronald G. Dusterhoft, et al.  
Serial No.: 10/760,649  
Filed: January 20, 2004  
Entitled: EXPANDABLE WELL SCREEN  
HAVING TEMPORARY SEALING  
SUBSTANCE  
Group Art Unit: 3672  
Examiner: K. Thompson

**PRE-APPEAL BRIEF REQUEST FOR REVIEW  
ARGUMENTS**

Pursuant to the Advisory Action dated March 7, 2006, claims 1, 3, 5, 10, 13, 22 and 29 remain rejected as being obvious over a proposed combination of U.S. Patent No. 6,394,185 (Constien) and U.S. Patent No. 2,981,332 (Miller). The applicants respectfully traverse these rejections and, since there is an omission of one or more essential elements needed for a *prima facie* rejection, along with clear error in the factual basis for the rejections, this Pre-Appeal Brief Request for Review is submitted accompanying a Notice of Appeal.

The present application describes a unique expandable well screen with a degradable temporary sealing substance impregnated in a filter media of the screen. The temporary sealing substance allows the screen to be installed while fluid is circulated through the screen. The sealing substance prevents large volumes of fluid from being pumped through the filter media while the screen is being installed, and eliminates the need for a washpipe to isolate the filter media from the circulated fluid. After installation of the screen, the sealing substance can be degraded to thereby allow produced fluid to flow through the filter media.

All of the independent claims presently pending in the application require that the screen include a temporary sealing substance preventing fluid flow through a wall or filtering layer of the screen. Independent claim 1 further recites that the screen is

expanded in the wellbore, and the sealing substance is degraded to thereby permit fluid flow through the filtering layer. Independent claim 10 recites that the screen is conveyed into the wellbore while the sealing substance prevents fluid flow through the screen wall, and the sealing substance is degraded to thereby permit fluid flow through the screen wall. Independent claim 29 recites that the screen has expanded and unexpanded configurations in the well.

The Constien reference is used in the obviousness rejections for its purported teaching of a temporary sealing substance impregnated in a filtering layer of a well screen. However, Constien actually describes a screen coating which is used to dissolve drilling mud filtercake and other drilling solids. There simply is no description in Constien of using the coating to temporarily prevent fluid flow through the screen.

One might imagine that Constien could use his coating to prevent flow through the screen. A person skilled in the art who is now enlightened by the teachings contained in the present application might realize that Constien's coating, if properly designed, could be used not only to dissolve mud cake and other drilling solids, but also to temporarily seal off the screen. In hindsight, Constien's screen might have performed even better if he had thought of using his coating to prevent flow through his screen.

But the proper test of a *prima facie* basis for a claim rejection is whether the reference actually teaches the recited claim limitations. In the present case, the reference teaches a coating which dissolves mud cake and other drilling solids. The reference does not teach that the coating prevents fluid flow through the screen. The word "seal" does not appear at all in the Constien reference. In contrast, the present claims recite that the sealing substance prevents fluid from flowing through the filtering layer or wall of the screen. Therefore, the reference does not even suggest what is claimed, much less teach what is claimed, and a *prima facie* case has not been made out.

In the Advisory Action, it is suggested that the Constien reference, "discloses the coating fills and coats the porous flow channels of the screen which serve to prevent flow through it." However, although the reference does describe the screen having the

coating impregnated therein (e.g., at col. 3, lines 39-42), the reference does not describe that the coating in any manner prevents flow through the screen.

It will be appreciated that many different types of coatings exist, some of which could operate to seal against fluid flow, and others of which would not seal against fluid flow. Constien does not specify any sealing abilities of his coating. It is quite possible that Constien's coating would not prevent flow of fluid through the screen.

For example, swimming pool and drinking water filters are provided with coatings which trap bacteria and viruses without preventing flow of water therethrough. Air filters are provided with coatings which trap dust without preventing flow of air through the filter. Printing screens are coated without preventing flow of ink therethrough. Thus, it is well known that a screen or filter can have a coating, without that coating preventing flow of fluid through the screen or filter. In a similar manner, well screens can be provided with coatings which do not prevent flow of fluid through the screens.

For at least the above reasons, a *prima facie* case of obviousness has not been made out. In addition, there is no motivation for combining the Constien and Miller references as proposed in the Office Action.

Miller describes a screen with a filtering layer made of an expandable sponge rubber or foam material. The filtering layer is released to expand by dissolving an outer sheath or bands initially restraining the filtering layer. Although the Office Action states that Miller describes expanding after degrading, the degrading taught by Miller is degrading of the sheath or band which holds the sponge rubber in a compressed configuration, not degrading of a temporary sealing material.

It is unclear how a person skilled in the art would be motivated to combine the teachings of Miller with those of Constien to produce the invention recited in the independent claims. Clearly, this motivation is not contained in either of the references. Indeed, neither of the references is even directed to the problem of preventing flow through the filtering layer of an expandable screen. Instead, Constien is directed to the

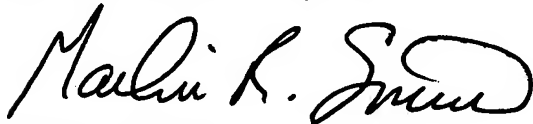
problem of releasing reactive materials into an area about a screen, and Miller is directed to the problem of expanding a filtering layer of a screen.

The only reason given in the Office Action for combining Constien and Miller is that Miller's expanding screen would fill the annular space in the wellbore. This is not a sufficient motivation to combine a reference which is directed to delivering a substance for dissolving filtercake with a reference which is directed to an expandable sponge rubber screen. Would the sponge rubber expand if it had Constien's coating in it? Probably not. Constien certainly did not suggest using his coating in a sponge rubber filter layer. Miller also did not suggest using his sponge rubber screen to deliver filtercake dissolving materials into a wellbore.

In summary, the references do not teach the elements and limitations recited in the independent claims, there is no motivation or reasonable expectation of success for combining the references, and a *prima facie* case of obviousness has not been made out. Accordingly, withdrawal of the rejections is respectfully requested.

Respectfully submitted,

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Dated: April 15, 2006

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on APRIL 17, 2006  
Sherna Sufko